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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,071	10/29/2003	Barbara A. Graham	14350-43810	8143

26257 7590 02/26/2007  
RODEY, DICKASON, SLOAN, AKIN & ROBB, PA  
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ALBUQUERQUE, NM 87103

EXAMINER
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PLUCINSKI, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/697,071	<b>Applicant(s)</b> GRAHAM, BARBARA A.	
	<b>Examiner</b> Jamisue A. Plucinski	<b>Art Unit</b> 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____                                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____   | 6) <input type="checkbox"/> Other: ____                           |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 1 recites the limitation "said mailing labels". There is insufficient antecedent basis for this limitation in the claim. Previously recited was a single mailing label, therefore it being unclear what multiple labels this is referring to.
4. Claim 2 recites the limitation "the geographic location". There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hewlett-Packard (Article from South China Morning Post Doc ID 57607106) in view of The Recycling Process ([www.uoregon.edu/~recycle/after\\_collection.html](http://www.uoregon.edu/~recycle/after_collection.html)).

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7. With respect to Claim 1: discloses a method for facilitating the recycling of items comprising the steps of distributing items to at least one recipient, providing a prepaid/preaddressed UPS mailing label on the carton so that the item can be mailed back to a recycling facility for the item (See Hewlett-Packard article, Page 1).
8. Hewlett-Packard however teaches the use of printer cartridges being recycled, and fails to teach the use of the items being printed communications. The Recycling Process teaches that it is old and well known in the art to recycle printed matter such as newspapers and magazines (see Introduction). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Hewlett-Packard process to have well known recyclable material such as newspapers or magazines be the items that are provided with pre-paid return labels, in order to make it easier for a user to recycle material in order to conserve natural resources and fossil fuels. (See Recycling Process, Page 1 and Hewlett-Packard, Page 1)
9. With respect to Claim 3: Hewlett-Packard discloses the mailing labels are affixed to the box prior to distribution (See Page 1)
10. With respect to Claims 4-6: Hewlett-Packard discloses the mailing labels are attached to the items prior to distributing the items, however fails to disclose alternative ways of including the mailing labels, such as including the mailing label with the item so that the label is affixed to the item after distribution, and affixing the label to the item prior to distribution and covering the label, so that the label is uncovered after distribution. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to

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have the label either attached after distribution of the item, or covered prior to distribution and uncovered after distribution because Applicant has not disclosed that having the label either attached after distribution of the item, or covered prior to distribution and uncovered after distribution provides an advantage, is used for a particular purpose or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either the mailing label attached to the item prior to distribution as taught by Hewlett-Packard, or having the label either attached after distribution of the item, or covered prior to distribution and uncovered after distribution because all three methods perform the same function of providing a user with a pre-paid label in which a user can return an item to be recycled after use, therefore making the recycling of the product easier. Therefore, it would have been an obvious matter of design choice to modify Hewlett-Packard to obtain the invention as specified in Claims 4-6.

11. With respect to Claim 7: The Recycling Process teaches the process of separating the ink from the paper before the paper is recycled (See Page 2 2<sup>nd</sup> paragraph).

12. With respect to Claims 8-10: It is old and well known in the art that items such as newspapers or even printer cartridges are distributed to a residence, businesses (such as doctor's offices) and sold at retail stores such as Target or Wal-Mart. Therefore, it would have been obvious to modify Hewlett-Packard and the Recycling Process to have the items distributed to either a residence, business or being sold in a store in order to products to be readily available to consumers.

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13. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hewlett-Packard and The Recycling Process as applied to claim 1 above, and further in view of Del Mol Van Otterloo et al. (US 2003/0023496), herein referred to Otterloo.

14. With respect to Claim 2: Hewlett-Packard and The Recycling Process, fail to specifically disclose the step of selecting a recycling facility based on the geographic location of the recipient. Otterloo discloses the use of a return label where the addressed return label based on the geographic location of the user (see Paragraph 0024 and Step S823). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the step of selecting a return facility based on geographic location, as disclosed by Otterloo, in order to increase the efficiency of the return process (See Otterloo, Page 5).

### *Conclusion*

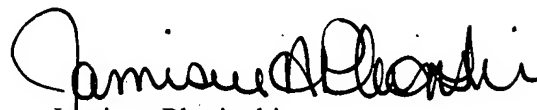
15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Howard, Brian (article: Fussing with Filters) discloses the use of a filter return and recycle program, Modern Purchasing (Article: Cartridges heading for refill, not landfill) discloses cartons of copier and paper toner cartridges are shipped with a pre-paid shipping label where a specified company will pick up the item and deliver to a recycling center, Minutillo (5,737,903) discloses the use of a newspaper recycling system, Gardner (6,945, 424) discloses the use of a newspaper recycling container, Whitt et al. (5,117,976) discloses the use of a packaging for batteries which functions as a recycling mailer for returning batteries which are recyclable, and Grey et al. (5,146,732) discloses the use of a recycle shipping assembly.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Plucinski whose telephone number is (571) 272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jamisue Plucinski  
Patent Examiner  
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